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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,257	03/10/2004	Xavier Billot	MC080Y	5365
210	7590	09/09/2005	EXAMINER	
MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907			HABTE, KAHSA Y	
			ART UNIT	PAPER NUMBER
			1624	
DATE MAILED: 09/09/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/797,257

Applicant(s)

BILLOT ET AL.

Examiner

Kahsay Habte, Ph. D.

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1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 9-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5 and 8 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/13/05 & 10/14/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. Claims 1-6 and 8-17 are pending in this application.

### ***Election/Restriction***

2. Applicant's election with traverse of Group II, Claims 1-3, 5-6 and 8 in a paper filed 8/31/2005 is acknowledged. The traversal is on the ground(s) that the "present invention is closely related in structure and use as agonist of EP<sub>4</sub> receptor. Although the variation exists in the X and Y substituents of the piperidino groups, the hetero groups are all drawn to the compounds of EP<sub>4</sub> agonists and can be used to treat a subject suffering from ocular diseases such as glaucoma and ocular hypertension." Applicants also argue that the coexamination of the additional groups would not require an additional burden of search. This is not found persuasive because Groups I and III-VI do not belong to the same recognized class of chemical compounds in the art, and references anticipating one invention, would not render obvious the others. Separate searches in the literature as well as in the U.S. Patent Classification System would be required. Each group's compounds are made and used independently of each other and could support separate patents. The compounds differ significantly in chemical structures. One skilled in the art would not consider such diverse structure equivalents of each other. Note that restriction is proper if two or more claimed inventions are either independent **or** distinct. see MPEP 803. Furthermore coexamination of each of the additional groups would require search of subclasses unnecessary for the examination of the elected claims. For example, the search for the invention of Group I

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would include search of subclass 544/54, the search for the invention of Group III would include search of subclass 546/243, the search for the invention of Group IV would include search of subclass 544/59 and the search for the invention of Group V would include search of various subclasses in class 514. Therefore, coexamination of each of these additional inventions would require a serious additional burden of search.

The requirement is still deemed proper and is therefore made FINAL.

3. The claims are drawn to multiple inventions for reasons set forth in the restriction requirement. The claims are examined only to the extent that they read on the elected invention. Cancellation of the non-elected subject matter is recommended in response to this Office Action.

### ***Objection***

4. Note that claim 6 is objected to because it contains non-elected species, but would be allowable if the non-elected species are deleted.

### ***Claim Objections***

5. Claim 1 is objected to because of the following informalities: the term "Ch=CH" is a typographical error. It should read as "CH=CH".

***Information Disclosure Statement***

6. Applicant's Information Disclosure Statement, filed on 6/13/2005 and 10/14/2004 has been acknowledged. Please refer to Applicant's copies of the 1449 submitted herewith.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 5 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. Claim 1 and claims dependent thereon are rejected because the phrase "Z represents a triple bond" is not clear. What triple bond? Is this C to C triple bond? Is this C to N triple bond? If applicants intend C to C triple bond, they have to draw or name the triple bond as it was done for C to C double bond (i.e. Z = CH=CH).

b. In claim 1, the phrase "Q is ....C(halo)<sub>2</sub> said cycloalkyl" is not clear. Is this a typo? There should be comma to separate "C(halo)<sub>2</sub>" from "said cycloalkyl".

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c. In claim 1, the phrase "R<sup>1</sup> represents....(CH<sub>2</sub>)<sub>p</sub>-hydroxymethylketone" is not clear. What is "hydroxymethylketone"? What is the structure of "hydroxymethylketone"? Ketone (RCO-R) is a molecule and not a moiety.

d. In claim 1, the phrase "Ra further represents for aryls and heterocyclyl" is not clear. How can Ra represent an aryl or heterocyclyl? What is the relation of Ra to "aryls" or heterocyclyl?

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

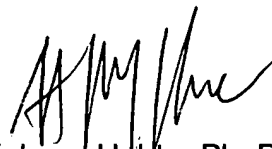
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Kahsay Habte', written over the printed name.

Kahsay Habte, Ph. D.  
Patent Examiner  
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KH

September 7, 2005